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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,338	03/10/2005	Kazunori Kusano	P26462	3526
7055 7590 05/30/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
SINGH, SUNIL K				
ART UNIT		PAPER NUMBER		
3732				
NOTIFICATION DATE		DELIVERY MODE		
05/30/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary

Application No.

10/527,338

Applicant(s)

KUSANO, KAZUNORI

Examiner

Sunil K. Singh

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In paragraph [0023], the applicant states "The ion conductive paste retained in the probe syringe may be selected from pastes having ion conductivity or aqueous dispersion." According to this statement, the examiner believes that the ion conductive paste can either be ion conductive **or** aqueously dispersed. Therefore, it is unclear how the "ion conductive paste" can still be ion conductive if it is being selected from pastes having aqueous dispersion.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusano (US 6,508,647) in view of Schibler et al. (US 2,986,542).

Kusano discloses a kit (Figs. 7 and 8) that includes: a probe syringe (1); a current detector device (101); a discharge part (4) formed with a flexible hollow material (Column 6, Lines 40-41) and being positioned on top of the probe syringe (Fig. 3a); a cylinder part (2) continuous to said discharge part and retaining an ion conductive paste

(D) (Fig. 3a); a piston (3) inserted into cylinder (Fig. 3a); and an electric conductive member (10) (Column 7, Lines 1-10) connecting inner and outer areas of said probe syringe and disposed across the discharge part (Figs. 3a and 3b) (Column 3, Lines 28-45); and the ion conductive paste comprises conductive material selected from the group propylene glycol (Column 4, Line 33; and Column 2, Line 57). However, Kusano fails to disclose the ion conductive paste being aqueously dispersed and having thixotropic properties and wherein the thixotropic ion conductive paste has the viscosity from 0.1 Pa to 5 Pa and thixotropy.

Schibler teaches the use of a paste having thixotropic properties in order provide a paste that is stable in storage and can be easily stirred in an aqueous thickening or binding agent and can therefore have aqueous dispersion (Column 5, Lines 1-5; Column 6, Lines 23-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kusano by including an ion conductive paste that has thixotropic properties, as taught by Schibler, in order provide a paste that assumes thinly viscous consistency after being stirred. However, Kusano/Schibler fail to disclose the thixotropic ion conductive paste having a viscosity that ranges from 0.1 Pa to 5 Pa. It would have been obvious to one having ordinary skill in the art to modify Kusano/Schibler by including a thixotropic ion conductive paste having a viscosity in the range from 0.1 Pa to 5 Pa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

4. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kusano (US 6,508,647) in view of Schibler et al. (US 2,986,542) further in view of Caizza (US 5,964,737).

Kusano/Schibler discloses the invention substantially as claimed except for a syringe having a discharge part made of silicone rubber.

Caizza teaches a syringe having an end piece (34 in Fig. 2b) made out of silicone rubber in order to provide a tip with elastomeric properties (Column 7, Lines 43-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kusano/Schibler by having the discharge part of the syringe being made of silicone rubber, as taught by Caizza, in order to provide a syringe tip with elastomeric properties.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Schibler is not analogous art and that Schibler does not teach an ion conductive paste.

In response to applicant's argument that Schibler is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art is in the same field of paste. Furthermore, Schibler is not being used to teach an ion conductive paste. Rather, Schibler is being used to teach the benefits of

Art Unit: 3732

using pastes that have thixotropic properties and that can be aqueously dispersed (see rejection above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil K. Singh whose telephone number is (571) 272-3460. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris L. Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

05/16/2008
/Melba Bumgarner/
Primary Examiner, Art Unit 3732

/Sunil K Singh/
Examiner
Art Unit 3732